

Patent 6,289,371 (Kumpf '371), U.S. Patent 6,168,444 (Cukor), and U.S. Patent 6,223,223 (Kumpf '223).

The rejections are all respectfully traversed, since it is Applicant's firm belief that the requirements for a *prima facie* case of obviousness have not been met. Pursuant to MPEP § 2143^{1/}, to establish a *prima facie* case of obviousness, three basic criteria must be met: there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings; there must be a reasonable expectation of success; and the prior art reference or references when combined must teach or suggest all of the claim limitations.

Here, it is respectfully asserted that there is not teaching or suggestion in the art to modify the references as combined in the Office Action, with a reasonable expectation of success. Moreover, even when combined, the combination still fails to teach all of the claim limitations. This is explained in greater detail below.

The invention concerns fulfillment of a scan order over a computer network, in which a scan setting is input at a computer terminal such that when a computer comprising an order entry server retrieves a scanner node, it retrieves a scanner node having a scan capability corresponding to the input scan setting.

Thus, in one representative embodiment of the invention, there is a local computer terminal, an order entry server computer, and a scanner node. The local

^{1/}The requirements of MPEP § 2143 might not be the only legal framework for establishing obviousness, but is apparently the legal framework relied on in the instant Office Action.

computer terminal is configured to instruct the order entry server computer, and specifically is configured to instruct the order entry server computer to retrieve a suitable scanner node and to create a scan order which specifies a process to be executed by the retrieved scanner node. The scanner node is configured to select the scan order from a plurality thereof. Further, the scan order itself includes a destination where the scan image should be sent.

In entering its rejection over Lo in view of Cunningham and further in view of Owa, the Office Action conceded that Lo does not have any description that the scan order includes a destination where the scan image should be sent, that the scanner node selects the scan order from a plurality thereof, and that the local computer instructs an order entry server to retrieve a suitable scanner node. The Office Action asserted that these structures are disclosed in the cited references to Cunningham and Owa. For his part, however, Applicant respectfully asserts that the Office Action offered an inadequate rationale as to why there is motivation or suggestion to combine Lo with Cunningham and Owa, with a reasonable expectation of success.

For example, the Office Action's rationale for combining Lo with Cunningham is found at the bottom of page 3 of the Office Action:

"Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the network image scanning system of *Lo et al* by having at least one computer terminal adapted to receive input including any address for sending scanning image, the address being input by a requestor ***because the system has the ability to send the scanned image to a third party.***" (Office Action dated October 6, 2006, page 3, emphasis added.)

Although it might be true that the combined system might have the ability to send a scanned image to a third party, such an ability does not constitute art-based evidence of a suggestion or motivation for making a combination. Rather, such an ability is nothing more than the observation of an advantage that might inure to the combination once the combination has already been made. Thus, page 3 of the Office Action simply describes an advantage of the combination, without specifying a rationale as to why such a combination might be made in the first place.

Likewise, the paragraph bridging pages 4 and 5 of the Office Action provides the USPTO's rationale for combining the Lo/Cunningham combination with the disclosure of Owa:

“Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the network image scanning system of *Lo et al* in view of *Cunningham* by having the client specify the desired scanning functions/capabilities for a particular scan order and then implementing a selection process that matches the user's desired parameters with a suitable scanning device capable of fulfilling the user's scan order -- ***this provides an efficient way for selecting optimum scanning devices that meet the user's expectations, without having the users manually search for printers with the desired specifications.***” (Office Action dated October 6, 2006, pages 4-5, emphasis added.)

Again, the provision of an efficient way to select optimum scanning devices might be an advantageous effect of the combination once it is already made, but it is not an art-based explanation of why there is motivation or suggestion to make the combination in the first place. Stated another way, there is no art-based evidence that Lo or Cunningham or Owa saw some deficiency in the way of selecting optimum scanning devices, and that this

deficiency might be ameliorated in a way suggestive of a combination of Lo and Cunningham and Owa.

MPEP §2143.01 provides (at page 2100-128) that “[t]he mere fact that references *can* be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination.” (Emphasis in original.) Here, the Office Action relied on speculation of an advantageous effect in the combination. However, there is no recognition in the references themselves that these advantages would have been produced by the combination. Compare, for example, MPEP § 2144: “the strongest rationale for combining references is a *recognition*, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination.” (Emphasis added.) In contrast, and as explained above, the prior art itself does not recognize any of the advantages posited in the Office Action. Accordingly, these advantages are nothing more than a *post hoc* rationalization of expected advantages, and not art-based recognition that these advantages would, in fact, be produced if the combination were made.

Moreover, although Lo and Cunningham appear to be related to network-based scanning systems, Owa is not. Rather, Owa is completely unconcerned with a network-based scanning system, and rather is directed to printing systems, as conceded in the Office Action. Thus, it is respectfully asserted that Owa is not even analogous art, in the sense that Owa is not in the field of Applicant’s endeavor (i.e., network-based

scanning) and is also not reasonably pertinent to the particular problem with which the Applicant was concerned. See MPEP § 2141.01(a).

It is therefore respectfully submitted that a *prima facie* case of obviousness has not been established, at least for the reason that there is no art-based suggestion or motivation for combining references, coupled with a reasonable expectation of success. Furthermore, *prima facie* obviousness also fails because, even when considered in the proposed combination, the prior art references fail to teach or suggest all of the claimed limitations.

Specifically, the Cunningham reference describes the scanning of a trailer page, as shown in Figure 4 thereof. The trailer page includes destination information, and this information is thus created on the scanner side. However, in the invention, the scan order is created by an order entry server, and it is created in response to an instruction from the local computer. Moreover, according to the invention, a scan order is selected from a plurality thereof, and the selection is made in a scanner node. No such disclosure is found in the combination of references proposed in the Office Action.

Indeed, the constituent components of the invention, together with their associated functionalities, are not seen in the proposed combination. With reference to representative Claim 1, for example, there are the following components and associated functionalities:

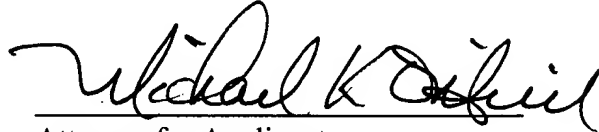
a computer terminal	<ul style="list-style-type: none"> - inputs a scan setting - instructs an order entry server computer, specifically, instructs the order entry server computer to retrieve a suitable scanner node and to create a scan order
order entry server computer	<ul style="list-style-type: none"> - respond to the instruction by the computer terminal, and specifically responds by retrieving a suitable scanner node and creating a scan order
scanner node	<ul style="list-style-type: none"> - selects a scan order from a plurality of scan orders
scan order	<ul style="list-style-type: none"> - includes at least one network address to which the scanned image is sent, wherein the address is input by a requestor and the scan setting input to the computer terminal

The division of specifically-claimed functionality amongst specifically claimed constituent components is simply not seen in the applied references, whether considered alone or in any reasonable combination.

It is therefore respectfully submitted that the claims herein define subject matter that would not have been obvious from any permissible combination of references, and allowance thereof is respectfully requested.

Applicant's undersigned attorney may be reached in our Costa Mesa,
California office at (714) 540-8700. All correspondence should continue to be directed to
our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael K. O'Neill", written over a horizontal line.

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